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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,776	12/22/2000	Jonathan Kepecs	18477-000710US	4405

20350 7590 03/03/2004

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EXAMINER
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GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/747,776

Applicant(s)

KEPECS, JONATHAN

Examiner

Stephen M Gravini

Art Unit

3622

M.W.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-89 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 & 38-39, drawn to a subcombination method, classified in class 705, subclass 14.
- II. Claims 12-23 & 40-41, drawn to combination/subcombination method, classified in class 705, subclass 1.
- III. Claims 24-36 & 42-44, drawn to subcombination/combination method, classified in class 709, subclass 223.
- IV. Claim 37, drawn to a subcombination, classified in class 709, subclass 225.
- V. Claim 45, drawn to a subcombination method, classified in class 705, subclass 11.
- VI. Claims 46-55, drawn to an apparatus subcombination, classified in class 705, subclass 15.
- VII. Claims 56-66, drawn to an apparatus combination/subcombination, classified in class 709, subclass 219.
- VIII. Claims 67-78, drawn to an apparatus subcombination/combination, classified in class 709, subclass 217.
- IX. Claims 79-88, drawn to an apparatus subcombination, classified in class 705, subclass 50.

Art Unit: 3622

- X. Claim 89, drawn to an apparatus subcombination, classified in class 705, subclass 60.

The inventions are distinct, each from the other because of the following reasons:

Inventions of groups I-V and groups VI-X are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process invention of interpedently claimed groups I-V are not limited by the independently claimed communication network apparatus of groups VI-X, such that the process invention can be practiced by another materially different apparatus or by hand.

Inventions of group I and groups II-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group I has separate utility such as generating a first offer for the first consumer, the first offer offering a first product for purchase by the first consumer at a first price for a first time period. This independently claimed feature is considered to show separate usability. See MPEP § 806.05(d).

Inventions of group II and groups I & III-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group II has separate utility such as generating a first offer offering a product from the

· Art Unit: 3622

plurality of products for purchase by the first consumer for a first time period, wherein sale of the product offered by the first offer provides a first profit margin for the seller. This independently claimed feature is considered to show separate usability. See MPEP § 806.05(d).

Inventions of group II and group III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the independently claimed subcombination feature of receiving a first and a second threshold then offering the first offer and determining if a consumer purchased a product offered during a first time period is considered particulars not required for the independently claimed combination of group II. The subcombination has separate utility such as limiting an offer to a time period without a seller profit margin.

Inventions of group III and groups I-II & IV-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group III has separate utility such as the independently claimed subcombination feature of receiving a first and a second threshold then offering the first offer and determining if a consumer purchased a product offered during a first time period. This

Art Unit: 3622

independently claimed feature is considered to show separate usability. See MPEP § 806.05(d).

Inventions of group IV and groups I-III & V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group IV has separate utility such as the independently claimed subcombination feature of generating a first offer corresponding to a first state of the state machine, the first offer offering a product from the plurality of products for purchase by the first consumer for a first time period. This independently claimed feature is considered to show separate usability. See MPEP § 806.05(d).

Inventions of group V and groups I-IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group V has separate utility such as the independently claimed subcombination feature of code for transitioning from the first state to a second state of the state machine based on first marketing criteria associated with the first state. This independently claimed feature is considered to show separate usability. See MPEP § 806.05(d).

Inventions of group VI and groups VII-X are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group VI has separate utility such as generating a first offer for the first consumer, the first offer offering a first product for purchase by the first consumer at a first price for a

Art Unit: 3622

first time period. This independently claimed feature is considered to show separate usability. See MPEP § 806.05(d).

Inventions of group VII and groups VI & VIII-X are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group VII has separate utility such as generating a first offer offering a product from the plurality of products for purchase by the first consumer for a first time period, wherein sale of the product offered by the first offer provides a first profit margin for the seller. This independently claimed feature is considered to show separate usability. See MPEP § 806.05(d).

Inventions of group VII and group VIII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the independently claimed subcombination feature of receiving a first and a second threshold then offering the first offer and determining if a consumer purchased a product offered during a first time period is considered particulars not required for the independently claimed combination of group VII. The subcombination has separate utility such as limiting an offer to a time period without a seller profit margin.

Art Unit: 3622

Inventions of group VIII and groups VI-VII & IX-X are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group VIII has separate utility such as the independently claimed subcombination feature of receiving a first and a second threshold then offering the first offer and determining if a consumer purchased a product offered during a first time period. This independently claimed feature is considered to show separate usability. See MPEP § 806.05(d).

Inventions of group IX and groups VI-VIII & X are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group IX has separate utility such as the independently claimed subcombination feature of generating a first offer corresponding to a first state of the state machine, the first offer offering a product from the plurality of products for purchase by the first consumer for a first time period. This independently claimed feature is considered to show separate usability. See MPEP § 806.05(d).

Inventions of group X and groups VI-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group X has separate utility such as the independently claimed subcombination feature of code for transitioning from the first state to a second state of the state machine based



Art Unit: 3622

on first marketing criteria associated with the first state. This independently claimed feature is considered to show separate usability. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since the restriction is complex and examiner knows from past experience that an election will not be made by telephone, this written restriction is proper under MPEP 812.01.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose voice telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The facsimile transmission telephone numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9306
Non-Official/Draft	(703) 872-9325

  
STEPHEN GRAVINI  
PRIMARY EXAMINER

smg  
March 1, 2004